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REMARKS

Claims 1-29 are currently pending. The Examiner has rejected claims 1-5, 7-14, 16-23, and 25-29 and has objected to claims 6, 15, and 24.

Allowable Subject Matter

Applicants greatly appreciate the indication in the Office Action that Claims 6, 15, and 24 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants believe, however, that each of claims 1-29 is currently in condition for allowance for the reasons stated below.

Claim Rejections

35 U.S.C. §102

The Office Action rejected Claims 1-5, 8 and 28 under 35 U.S.C. 102(b) as being anticipated by Fingleson et al (US 5,479,661).

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.

As to claim 1, the Examiner stated, at page 2 of the Office Action, that U.S. Patent No. 5,479,661 to Fingleson et al. ("Fingleson") "discloses a breast self-examination apparatus, garment 10, including a form-fitting garment (since it fits a wearer's form as broadly claimed) with at least one examination pattern 38, 40 (See Fingleson col. 3, lines 35-67 and col. 4, line 10) disposed on the garment". Applicants respectfully submit that Fingleson fails to teach a breast self-examination apparatus comprising a form-fitting garment and at least one examination pattern disposed on said

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garment at least because Fingleson fails to teach a form-fitting garment. Specifically, Fingleson fails to explicitly teach that garment 10 is form-fitting, and as is clearly shown in Fig. 8, garment 10 is not form-fitting so as to allow the hand of a wearer to be inserted between garment 10 and the wearer's body (see also col. 3, lines 20-25).

As to claim 2, the Examiner stated, at page 2 of the Office Action, that Fingleson further teaches that "the garment is shirt-like and formed from a thin material (see col. 3, lines 1-4)." Applicants respectfully submit, however, that Fingleson fails to teach that the garment is shirt-like and fabricated from a thin material. Specifically, the cited portion (and the entire disclosure) of Fingleson fails to teach that garment 10 is shirt-like and further fails to teach that garment 10 is fabricated from a thin material. As seen in Figs. 1, 2, 4, 6, and 8, garment 10 is not shirt-like but is instead sheet-like, constructed of two rectangular panels (see col. 2, lines 62-67). Furthermore, Fingleson teaches, at col. 3, lines 1-4, that garment 10 is manufactured of a soft, flexible woven fabric and can also be made of a plastic or a paper material, but fails to teach that garment 10 is fabricated from a thin material.

As to claim 3, Applicants respectfully submit that Fingleson fails to teach that said garment comprises a low-coefficient of friction to facilitate hand and finger movement over said at least one examination pattern as required by claim 3.

As to claim 5, Applicants respectfully submit that Fingleson fails to teach that said garment further comprises at least one alignment mark centrally disposed within said at least one examination pattern, said at least one alignment mark utilized to center a nipple of the breast of the wearer thereunder to properly align said at least one examination pattern over the breast. Specifically, Fingleson fails to teach centering an alignment mark over a nipple of the breast, either at the cited portion of the Fingleson specification, or elsewhere.

As to claim 28, the Examiner stated, at page 2 of the Office Action, that Fingleson "discloses the method of breast self-examination including obtaining the breast examination form fitting garment 10 with the pattern thereon 38, 40; putting on the garment, aligning the garment pattern with the breast and [sic] examining the breasts as claimed (see Fingleson col. 4, lines 10-23)." Applicants respectfully submit, however, that Fingleson fails to teach obtaining a breast self-examination apparatus comprising a form-fitting garment and at least one examination pattern disposed on said

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garment and putting on said garment, aligning said at least one examination pattern over a breast and examining and palpating the breast from the outside of said garment via guiding at least one finger over said at least one examination pattern. Specifically, Fingleson fails to teach at least that the garment is form-fitting, as discussed above, and further fails to teach examining and palpating the breast from the outside of said garment via guiding at least one finger over said at least one examination pattern.

Thus, since Fingleson fails to teach each and every limitation of claims 1-5, 8 and 28, applicant's respectfully request that claims 1-5, 8, and 28 are in condition for allowance and that the Examiner withdraw the rejection of claims 1-5, 8 and 28 under 35 U.S.C. 102(b) as being anticipated by Fingleson et al (US 5,479,661).

35 U.S.C. §103

As a preliminary matter, "the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. "To establish a *prima facie* case of obviousness. . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2142. Applicants respectfully submit that the Examiner has failed to meet the initial burden of factually supporting a *prima facie* case of obviousness for any of the claims discussed below. Specifically, the Examiner has failed to establish where each limitation of each claim is taught in the prior art. Such failure has precluded Applicants from preparing a detailed response to the Office Action. Applicants respectfully request that the Examiner fully establish where each claim limitation is taught in the prior art.

The Office Action rejected Claims 7, 11-14, 16 and 25 under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Morrison (US 4,873,982).

As to claim 7, the Examiner concedes, at page 3 of the Office Action, that Fingleson fails to disclose at least that the garment extends to the underarm area. The Examiner then states that "it is well known that the breasts, especially of large breasted women, extend to the underarm or side area women in addition the lymph glands affected by breast cancer [sic] also extend into the underarm area" and that "the Morrison garment is a breast examination garment that extends to an underarm or

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side area of the wearer. Applicants respectfully submit that claim 7 is allowable at least for the reasons stated above with respect to Claim 1. Applicants further respectfully submit that Fingleson additionally fails to teach that the garment further comprises at least one armpit examination pattern disposed under an armpit area of said garment. Furthermore, U.S. Patent No. 4,873,982 by Morrison ("Morrison"), likewise, fails to teach a breast self-examination apparatus wherein said garment further comprises at least one armpit examination pattern disposed under an armpit area of said garment.

As to claims 11, Applicants respectfully submit that claim 11 is allowable at least for the reasons stated above with respect to claims 1 and 7, specifically, that Fingleson fails to disclose at least a breast self-examination apparatus comprising a form-fitting garment and at least one armpit examination pattern disposed on said garment. Furthermore, since Morrison also fails to teach at least the at least one armpit examination pattern disposed on said garment, Morrison fails to overcome the deficiencies of Fingleson.

As to claim 12, Applicants respectfully submit that claim 12 is allowable at least for the reasons stated above with respect to claims 1, 2, 7, and 11.

As to claim 13, Applicants respectfully submit that claim 13 is allowable at least for the reasons stated above with respect to claims 1 and 11.

As to claim 14, Applicants respectfully submit that claim 14 is allowable at least for the reasons stated above with respect to claims 1, 5, and 11.

As to claim 16, Applicants respectfully submit that claim 16 is allowable at least for the reasons stated above with respect to claims 1 and 11.

As to claim 25, Applicant's respectfully submit that the rejection of claim 25 under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Morrison (US 4,873,982) is improper at least because claim 25 depends from claim 19, which was not rejected as being unpatentable over Fingleson in view of Morrison. Furthermore, Applicants respectfully submit that claim 19, and, thus, claim 25 are each allowable at least for the reasons set forth above with respect to claims 1 and 11. In addition, Applicants respectfully submit that claim 19, and, thus, claim 25 are each allowable at least because Fingleson and Morrison each fails to teach at least one marking instrument for marking or designating areas of suspected abnormalities directly on said garment. Finally, Applicants

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respectfully submit that claim 25 is allowable at least for the reasons set forth above with respect to claims 7 and 11.

The Office Action rejected Claims 9, 10, 19-23, 26, 27 and 29 under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Rusin (US 6,412,491).

As to claims 9, 10, 19-23, 26, 27 and 29, Applicants respectfully submit that claims 9, 10, 19-23, 26, 27, and 29 are allowable for at least the reasons stated above with respect to claims 1-3 and 5.

Applicants further respectfully submit that U.S. Patent No. 6,412,491 to Rusin ("Rusin") fails to teach a form-fitting garment.

As to claim 29 specifically, Applicants respectfully submit that the rejection of claim 29 under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Rusin (US 6,412,491) is improper at least because claim 29 depends from claim 28, which was not rejected under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Rusin (US 6,412,491).

The Office Action rejected claims 17, 18 and 25 under 35 U.S.C. 103(a) as being unpatentable over Fingleson et al in view of Morrison (US 4,873,982) and further in view of Rusin (US 6,412,491).

As to claims 17 and 18, Applicants respectfully submit that claims 17 and 18 are allowable at least for the reasons set forth above with respect to claim 11.

As to claim 25, Applicants respectfully submit that claim 18 is allowable at least for the reasons set forth above with respect to claims 7 and 19.

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Conclusion

Applicants respectfully submit that pending claims 1-29 are in condition for allowance at least for the reasons stated above, and respectfully request that the Examiner withdraw the rejection of claims 1-5, 7-14, 16-23, and 25-29.

If Examiner has any questions regarding this document, Applicants ask that Examiner contact Applicant's undersigned attorney.

Respectfully submitted,



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